

### **REMARKS**

This responds to the Office Action mailed on May 18, 2006, and the references cited therewith.

No claims are amended, no claims are canceled, and no claims are added; as a result, claims 1-15 and 19-26 are now pending in this application.

#### **§102 Rejection of the Claims**

Claims 1-15 and 19-23 were rejected under 35 U.S.C. § 102(e) for anticipation by Langheinrich et al. (U.S. 6,654,725).

To anticipate a claim, the reference must teach every element of the claim. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

**Claims 13 and 26: Langheinrich does not disclose each and every claim element.**

Claim 13 recites:

*A computer-readable medium having stored thereon executable instructions for causing a computer to perform a utility program for selecting images for a markup language document comprising:*

*determining a number of images to display in the markup language document;*  
*obtaining a set of random numbers corresponding to the number of images;*  
*retrieving images from a group of images using the set of random numbers; and*  
*placing the retrieved images in the markup language document.*  
(Emphasis Added)

Langheinrich provides that:

Note that the initial search page 13 already features a banner advertisement 11 that has been selected and supplied by the advertisement server 103 (FIG. 1), not the publisher's server 101.

(Langheinrich, Col. 4, ll. 47-50) (Emphasis Added)

In the process the publisher's script uses [2] the advertisement server selection API 119 to obtain an advertisement ID for the given customization parameters (for example the search keyword).

(Langheinrich, Col. 6, ll. 15-18) (Emphasis Added)

The system inserts a customized advertisement that matches the page content or search topic.

(Langheinrich, Abstract, Page 1) (Emphasis Added)

Thus, Langheinrich only discloses the insertion of one advertisement into the markup language document. Langheinrich does not disclose "determining a number of images to display in the markup language document" as recited in claim 13.

Futhermore, Langeinrich is limited to retrieving an image based on past data to maximize the click-through for a single advertisement.

Langheinrich provides that:

The advertisement server handles incoming request from clients to deliver customized advertisements. It contacts the database server 104 in order to obtain the data relevant to make an advertisement selection.

(Langheinrich, Col. 4, ll. 20-24) (Emphasis Added)

The other objective of the present invention is achieved by a method of providing electronic advertisements to a client system, the method comprising the steps of decoding customization parameters embedded in a request from the client system, querying a database for a list of display probabilities for relevant values of the customization parameters, computing and overall display probability for the overall request, and selecting an advertisement according to the display probability.

(Langheinrich, Col. 2, ll. 59-67) (Emphasis Added)

Langheinrich selects an advertisement based on display probabilities for each advertisement with the purpose of maximizing the click-through for each single advertisement. In contrast, claim 13 recites “retrieving images from a group of images using the set of random numbers.”

Because Langheinrich fails to disclose each and every element of claim 13, claim 13 and its dependent claims are patentable over Langheinrich and should be allowed.

Claim 26 recites “means for determining number of images to display in the markup language document” and “means for obtaining a set of random numbers corresponding to the number of images.” Claim 26 further recites “means for retrieving images from a group of images using the set of random numbers.” Therefore, claim 26 and its dependent claims are not anticipated by Langheinrich for at least the reasons provided above with respect to claim 13.

**Claims 19: Langheinrich does not disclose each and every claim element.**

Claim 19 recites “the utility program causes the processing unit to determine a number of images to display in the markup language document, selects the number of images from a group of images.” Therefore, claim 19 and its dependent claims are not anticipated by Langheinrich for at least the reasons provided above with respect to claim 13.

**Claims 1 and 25: Langheinrich does not disclose each and every claim element.**

With respect to the rejection of independent claims 1 and 25, certain of the arguments presented herein with reference to claim 13 apply. Claim 1 recites “selecting, by the utility program, a pre-determined number of images from a group of images, the pre-determined number being specified in the instruction.” Therefore, claim 1 and its dependent claims are not anticipated by Langheinrich for at least the reasons provided above with respect to claim 13. In addition, the office Action alleges:

Claim 1 recites:

*A computerized method for selecting images for a markup language document comprising:  
encoding an instruction in the markup language document, the instruction identifying a utility program that selects an image for insertion into the document;*

*preparing the markup language document for display;  
invoking the utility program when the instruction is processed;  
selecting, by the utility program, a pre-determined number of images from a group of images, the pre-determined number being specified in the instruction; and  
placing, by the utility program, the pre-determined number of images in the markup language document at locations defined in the instruction.*

Langheinrich discloses the following:

Once the user's browser 102 encounters the embedding tags it will contact [3] the advertisement server 103 to fill in a snippet of HTML code at the position the original tag was placed in the output of the publisher's application.

(Langheinrich, Col. 7, ll. 10-13) (Emphasis Added)

Langheinrich provides for the insertion of HTML code at the position of the original tag. There is no disclosure for placing the images "at locations defined in the instruction," as recited in claim 1. Thus, Langheinrich fails to disclose each and every element of claim 1.

Because Langheinrich fails to disclose each and every element of claim 1, claim 1 and its dependent claims are patentable over Langheinrich and should be allowed.

Claim 25 recites "means for selecting, by the utility program, a pre-determined number of images from a group of images, the pre-determined number being specified in the instruction" and "means for placing, by the utility program, the pre-determined number of images in the markup language document at locations defined in the instruction." Therefore, claim 25 and its dependent claims are not anticipated by Langheinrich for at least the reasons provided above with respect to claim 1.

### §103 Rejection of the Claims

Claims 12 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Langheinrich et al. in view of McCollom et al. (U.S. 6,925,444). Claims 12 and 14 are each allowable by virtue of being dependent on an allowable independent claim.

### CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at 408-278-4042 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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